

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC

Petitioner

v.

CARUCEL INVESTMENTS, L.P.

Patent Owner

Case No. IPR2019-01298
U.S. Patent No. 7,221,904

(Joined with IPR2019-01635)

**PATENT OWNER'S AMENDMENT TO APRIL 29, 2021
NOTICE OF APPEAL**

Via PTAB E2E

Patent Trial and Appeal Board

Via Hand Carry

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
Madison Building East, Room 10B20
600 Dulany Street,
Alexandria, VA 22314

Via CM/ECF

United States Court of Appeals for the Federal Circuit

Pursuant to 35 U.S.C. §§ 141(c), 142 and 319, and 37 C.F.R. §§ 90.2–3, Patent Owner, Carucel Investments L.P., hereby amends its previous Notice of Appeal filed in this matter on April 29, 2021, to expressly add the following orders subsequently entered by the Patent Trial and Appeal Board after appeal had been taken to the Federal Circuit. The February 7, 2022 Order denying the Request of Patent Owner, Carucel Investments LP for Director Review of the Final Written Decision (Paper 39).

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Patent Owner amends its April 29, 2021, Notice of Appeal to add the following issues to its pending appeal:

- vi. the Board’s failure to have the instant decision reviewed by an appropriate Principal Officer under *United States v. Arthrex, Inc.*;
- vii. the Board’s failure to utilize proper procedures and formal rules promulgated in compliance with the Administrative Procedures Act and the Due Process Clause of the Constitution in conducting review of the final written decision by an appropriate Principal Officer; and
- viii. all other issues decided adversely to Patent Owner in any order, decision, ruling, or opinion subsequently entered after the appeal had been taken.

All previous orders and issues identified in the original April 29, 2021 notice remain at issue in this appeal.

This Amendment has been sought within the time limits prescribed by the Federal Circuit's Docket Order Dated April 29, 2022.

Pursuant to 35 U.S.C. § 142 and 37 C.F.R. § 90.2(a), this Amendment is being filed with the Director of the United States Patent and Trademark Office. Simultaneously with this submission, Patent Owner is electronically filing a copy of this Amendment with the Patent Trial and Appeal Board. In addition, this Amendment is being filed electronically with the Clerk of the United States Court of Appeals for the Federal Circuit, which has indicated by order entered on April 29, 2022, that the Amendment need not include an additional docketing fee.

Date: May 6, 2022

Respectfully submitted,

/s/ R. Scott Rhoades

R. Scott Rhoades

Reg. No. 44,300

WARREN RHOADES LLP

2909 Turner Warnell Road, Suite 131,

Arlington, Texas 76001

Telephone: 972-550-2997

Facsimile: 469-422-0091

Email: srhoades@wriplaw.com

Lead Counsel for Patent Owner

CERTIFICATION OF FILING

Pursuant to 37 C.F.R. §§ 90.2(a)(1) and 104.2(a), the undersigned hereby certifies that in addition to being filed electronically through the Board's Patent Trial and Appeal Board's end to end system (PTAB E2E), a true and correct copy of the above-captioned PATENT OWNER'S AMENDMENT TO APRIL 29, 2021 NOTICE OF APPEAL is being filed delivered by hand to the Director of the United States Patent and Trademark Office on May 6, 2022, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
Madison Building East, Room 10B20
600 Dulany Street,
Alexandria, VA 22314

Pursuant to 37 C.F.R. §§ 90.2(a)(2), the undersigned also hereby certifies that a true and correct copy of the foregoing PATENT OWNER'S AMENDMENT TO APRIL 29, 2021 NOTICE OF APPEAL is being filed electronically through CM/ECF with the United States Court of Appeals for the Federal Circuit on May 6, 2022.

Date: May 6, 2022

Respectfully submitted,

/s/ R. Scott Rhoades

R. Scott Rhoades

Reg. No. 44,300

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that an electronic copy of the foregoing PATENT OWNER'S AMENDMENT TO APRIL 29, 2021 NOTICE OF APPEAL was served on the Petitioners by electronic mail on May 6, 2022:

qecarucelipr@quinnemanuel.com

Date: May 6, 2022

Respectfully submitted,

/s/ R. Scott Rhoades _____

R. Scott Rhoades

Reg. No. 44,300